

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of:

Toru OZAKI et al.

Serial No. 09/933,766

Group Art Unit: 3625

Confirmation No. 6192

Filed: August 22, 2001

Examiner: Matthew S. Gart

For: COMMERCE INFORMATION DISTRIBUTION SYSTEM AND COMMERCE
INFORMATION MANAGING METHOD

REPLY BRIEF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In the Examiner's Answer mailed April 28, 2008, the Examiner acknowledged that sections I - VI and the Claims Appendix of the Appeal Brief filed February 27, 2008 were correct and on pages 3-7 repeated the rejection of the claims from the July 24, 2007 Office Action with changes in formatting only.

Sahota does not teach "designating at least the commercial message broadcast"

In response to the argument in the Appeal Brief that paragraphs [0057] to [0060] of Sahota are more relevant to claim 1 than paragraph [0061], the Examiner responded "that paragraph [0061] is the most relevant teaching to ... [the] limitation" (Examiner's Answer, page 8, lines 19-20) "commercial message broadcast designation information ... designating at least the commercial message broadcast" (claim 1, lines 10-11), because "it explicitly teaches that a user can launch interactive content from the commercial that includes launching the retailer's website" (Examiner's Answer, page 8, lines 19-20). This was asserted to be

exactly the same as 'commercial message broadcast designation information (where providing the retailer website URL is the designation information) and 'designating at least the commercial message broadcast' (where embedding the retailer website URL is the designation of the message)

(Examiner's Answer, page 8, last line to page 9, line 4).

The preceding quote from the Examiner's Answer clearly states a basic error made by the Examiner in rejecting claim 1. Appellants have repeatedly contended that "the retailer website URL" does not and cannot "designate the message" as asserted by the Examiner. As one of ordinary skill in the art or any knowledgeable user of the Internet knows, "the retailer website URL" merely provides a link to a website. Upon arrival at the website, the page that is displayed is whatever was linked to by the URL. What is described in paragraph [0061] of Sahota is that "a user of TV 104 can launch interactive services by accessing interactive content 510 ... [to] begin interacting with a website as shown in FIG. 5B related to the clothing retailer." There is no mention in paragraph [0061] of Sahota regarding what is included in interactive content 510, but in Fig. 5A reference numeral 510 is associated with "http://www.xyz.com." As discussed in the Appeal Brief and apparent to one of ordinary skill in the art, a URL like "http://www.xyz.com" is incapable of "designating at least the commercial message broadcast" as required by claim 1. This type of URL merely points to the home page of the owner of the website "xyz.com." This is what was disclosed by Sahota, as opposed to what the Examiner has "interpreted" paragraph [0061] of Sahota as describing, in order to be closer to what is claimed.

The Appeal Brief pointed out that the example of interactive content 510 disclosed in Sahota, i.e., "http://www.xyz.com," is discussed in paragraph [0060] and the lack of discussion of interactive content 510 in paragraph [0061] of Sahota was one of the reasons that the Appeal Brief stated that paragraphs [0057] to [0060] of Sahota are more relevant to claim 1 than paragraph [0061]. Instead of rebutting this statement, the statements on page 8, line 17 to page 9, line 10 of the Examiner's Answer confirm the error of the Examiner's position and the accuracy of the statement in the Appeal Brief that paragraph [0061] of Sahota is not particularly relevant to claim 1, when read in context of the entire disclosure in Sahota.

Sahota does not teach "receiving at a broadcast reception terminal device of a client ... commercial message broadcast designation information"

At page 9, lines 10-15, the Examiner's Answer asserted that the arguments regarding the failure of Sahota to teach that "multiplexer/encoder 215 inserts the URL into the broadcast TV commercial" (Examiner's Answer, page 9, line 11) were "irrelevant" (Examiner's Answer, page 9, line 15), because "this feature is not claimed" (Examiner's Answer, page 9, line 14). However, claim 1 recites "receiving at a broadcast reception terminal device of a client, as part of the commerce information, commercial message broadcast designation information" (claim 1, lines

9-10). As discussed in the three paragraphs starting on page 7 of the Appeal Brief, this feature is not disclosed by Sahota.

One of the reasons that the limitation recited on lines 9-11 of claim 1 is not disclosed by Sahota is that it is not multiplexer/encoder 215, but rather device frameworks 270 that adds the content, i.e., the URL, on the screen while the broadcast television advertisement is being displayed. As described in paragraph [0038], "device frameworks 270 ... integrate[s] automatically an existing Internet advertising content, e.g., an advertisement banner, with a television commercial being broadcasted to set-top box 106 via broadcast network 290" where the existing Internet advertising content is received from "application server 240 via network 275..." It is clear from these statements and the illustration in Fig. 2 that Sahota discloses combining the "commercial message broadcast" (claim 1, line 3) with the "interactive content" (that the Examiner has asserted is "exactly the same" in Sahota as "commercial message broadcast designation information") by a device adjacent to set-top box 106 which receives the TV broadcast separately (see Fig. 2).

On the other hand, claim 1 requires "receiving at a broadcast reception terminal device ... commercial message broadcast designation information contained in the commercial message information." If the multiplexer/encoder 215 of Sahota inserted the "interactive content" into the "television commercial," then it might be possible for the system disclosed by Sahota to meet this limitation. However, because the "device frameworks ... integrate[s] ... Internet advertising content... with a television commercial" at the set-top box which receives the TV broadcast separately, the "interactive content" is not "contained in the commercial message information" (claim 1, lines 10-11) when the "television commercial" is received by the set-top box 106. Rather, the device frameworks modifies what is displayed by a TV connected to the set-top box when a commercial is received with the rest of the broadcast program (on the right side of set-top box 106 in Fig. 2). Thus, Sahota does not disclose the limitations recited on lines 9-11 of claim 1.

Disclosure in Sahota does not support rejection

The paragraph spanning pages 9-10 of Examiner's Answer starts with a summary of what is disclosed in Sahota that is reasonably accurate in stating that "[t]he website is designated based on the commercial message" (Examiner's Answer, page 9, line 20), but then the Examiner asserts that the opposite is required, i.e., "Sahota's ... integrat[ion of] Internet advertising with television commercials ... would not be possible without commercial message

broadcast designation information" (Examiner's Answer, page 9, lines 20-23). In fact, the integration is possible without meeting the limitations recited in claim 1, because Sahota, as accurately described in the summary provided by the first three sentences of the paragraph, discloses integrating a television commercial with a URL to a website of the company whose product or service is the subject of the television commercial when the television commercial is received at the set-top box. Nothing has been cited or found in Sahota suggesting that anything designating the television commercial is "receiv[ed]" at a broadcast reception terminal device, as part of the commerce information" (claim 1, lines 9-10).

As discussed above and repeatedly during the prosecution of this application, the URL of a website of a company does not designate the television commercial, it only designates the website of the company. No suggestion has been cited or found that whatever enables the URL of the website of a company to appear on a television commercial advertising a product or service of the company, is sent to a "broadcast reception terminal device" as required by claim 1. Thus, contrary to the assertions of the Examiner, what is disclosed in Sahota is not "a direct reading on the present invention" (Examiner's Answer, page 10, lines 3-4).

Examiner acknowledged inability to understand arguments

In the paragraph at page 10, lines 8-19 of the Examiner's Answer, the Examiner acknowledged that it was "unclear as to exactly what Appellants allege is missing from Sahota" (Examiner's Answer, page 10, lines 8-9). In other words, the Examiner acknowledged a lack of understanding of the issues of this appeal.

This paragraph also contained an assertion that the "last paragraph" on page 7 of the Appeal Brief "concede[d]" that Sahota teaches this feature" (Examiner's Answer, page 10, lines 14-15), referring to the preceding assertion that "Sahota paragraph [0061] and figure 1A describe a set-top box that receives broadcast designation information" (Examiner's Answer, page 10, lines 12-13). Appellants are uncertain which paragraph the Examiner believes conceded that Sahota teaches "a set-top box that receives broadcast designation information." The last full paragraph on page 7 of the Appeal Brief quoted an assertion in the July 24, 2007 Office Action and quoted claim language, but the only reference to what was disclosed in Sahota was that

the July 24, 2007 Office Action failed to provide any explanation of why what the TV displays matters, when [what is added to the commercial] ... is received ... via a different route from the TV broadcast via broadcast network 290, i.e., from application server 240 as illustrated in Fig. 2 of Sahota

(Appeal Brief, page 7, lines 18-25). Clearly, this is not a concession that "Sahota paragraph [0061] and figure 1A describe a set-top box that receives broadcast designation information."

If the Examiner was referring to the paragraph spanning pages 7 and 8, the only statements in this paragraph that relate to what is disclosed in Sahota was that "Fig. 1A of Sahota illustrates ... 'TV AND DATA BROADCAST' being sent from integration platform architecture 110 towards set-top box 106 and 'TV COMMERCIAL 108' and 'INTERNET ADVERTISING CONTENT 112' being displayed on TV 104" (Appeal Brief, page 7, lines 26-28). It is not understood how this could be construed as conceding that Sahota teaches "a set-top box that receives broadcast designation information" (Examiner's Answer, page 10, lines 12-13). Neither the paragraph spanning pages 7 and 8 of the Appeal Brief, nor anything that has been seen in the July 24, 2007 Office Action, suggested that "TV AND DATA BROADCAST" includes "commercial message broadcast designation information" as required by claim 1, and as discussed above and ahead of the paragraph spanning pages 7 and 8 of the Appeal Brief, "INTERNET ADVERTISING CONTENT 112" which appears on the TV 104 in Fig. 1A of Sahota does not contain "commercial message broadcast designation information," only a URL of a company's website. Therefore, it is not understood why the paragraph at page 10, lines 8-19 was included in the Examiner's Answer.

All claim limitations should be given patentable weight

In the paragraph spanning pages 10-11 of the Examiner's Answer, it was asserted that "the claimed data elements are not to be given patentable weight since the claimed data elements are non-functional descriptive material" (Examiner's Answer, page 11, lines 1-3). The following paragraph on page 11 asserted that the limitation "commercial message broadcast designation information contained in the commercial message information" (claim 1, lines 10-11) "is merely printed material contained in the commercial message information" (Examiner's Answer, page 11, lines 7-8). In making this statement, the Examiner appears to be confusing what is disclosed by Sahota with what is recited in the claims. While all that is disclosed by Sahota is a URL of a company's website displayed on a TV, which might be considered to be equivalent to "printed material," the "commercial message broadcast designation information" is required for the operations of the method recited in claim 1 to be performed and as a result are functionally related to the recited method.

The last four lines of claim 1 describes what happens after the information recited on lines 9-11 is received "at a broadcast reception terminal device of a client" (claim 1, line 9), i.e.,

"the client ... performs an instruction for displaying the commercial message information relating to the commercial message broadcast and purchases merchandise or a service in the commercial message information relating to the commercial message broadcast." These operations change, depending on what is contained in the commercial message information, i.e., the client "purchases merchandise or a service in the commercial message information" and thus, the details of the purchasing operation changes depending on what is contained in the commercial message information.

In support of the assertion that the details of the information received in claim 1 can be ignored as "non-functional" the Examiner cited *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and *In re Lowry*, 32 F3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). However, *In re Gulack* was limited to a specific fact situation where the court held

[w]here the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although **the printed matter must be considered**, in that situation it may not be entitled to patentable weight.

217 USPQ at 404, emphasis added. Furthermore, in a footnote, the court noted that

The CCPA has considered all of the limitations of the claims including the printed matter limitations, in determining whether the invention would have been obvious. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Cavrich*, 451 F.2d 1091, 172 USPQ 121 (CCPA 1971). In *Royka*, 490 F.2d at 985, 180 USPQ at 583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated.

217 USPQ at 404. Thus, it is submitted that *In re Gulack* does not support ignoring the content of the information recited in claim 1.

Similarly, *In re Lowry* does not support the Examiner's position that the content of the information can be ignored, but rather supports Appellants' position that the content must be considered. The court held

the Board erroneously extended a printed matter rejection under sections 102 and 103 to a new field in this case, which involves information stored in a memory. This case, moreover, is distinguishable from the printed matter cases. The printed matter cases "dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind." *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969). The printed matter cases have no factual relevance where "the invention as defined by the claims *requires* that the information be processed not by the mind but by a machine, the computer." *Id.* (emphasis in original).

32 USPQ2d at 1034. Thus, it is submitted that case law supports giving weight to the limitations in claim 1 describing the content of the information and how it is related to the operations performed "at a broadcast reception terminal device" (claim 1, line 9).

For at least the above reasons and the reasons set forth in the Appeal Brief, it is submitted that claim 1, as well as claims 2, 3 and 6-9 which depend therefrom, patentably distinguish over Sahota.

"Shop" is not an online store

In the paragraph spanning pages 11 and 12 of the Examiner's Answer, it was asserted "that the term shop is broad enough to include all type[s] of shops, including online stores" (Examiner's Answer, page 11, lines 22-23). Nothing was cited in support of this interpretation, other than *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1056 (Fed. Cir. 1993) for the general proposition that "limitations from the specification are not read in to the claims" (Examiner's Answer, page 12, line 2). However, why one of ordinary skill in the art (even ignoring the specification) would interpret the noun "shop" as including a "online store" was not explained. Nothing was cited indicating that the noun "shop" is used to refer to "online stores." In the absence of any evidence other than the Examiner's assertion, it is submitted that the noun "shop" is not commonly used to refer to an online store and therefore, one of ordinary skill in the art would not consider it reasonable to interpret the noun "shop" as encompassing "online stores."

For the above reasons, it is submitted that claim 8 further patentably distinguishes over Sahota.

Apparatus claims require separate analysis

In the paragraph at page 12, lines 10-17 of the Examiner's Answer, it was asserted that Appellants' arguments with respect to claim 28 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references (Examiner's Answer, page 12, lines 10-13).

First, it is noted that 37 CFR 1.111 is entitled "Reply by applicant of patent owner to a on-final Office action" and thus is not pertinent to an Appeal Brief.

Second, the discussion of claim 28 challenged the rejection in the July 24, 2007 Office Action by stating that "[n]othing has been cited in Sahota even suggesting that the advertising server(s) 230, application server 240, traffic server 250 and/or broadcasting server 260 meet the

limitations recited in claim 28" (Appeal Brief, page 10, lines 14-16). Instead of citing where Sahota teaches that any of these (or any other components disclosed in Sahota) perform the operations of the management unit recited on lines 9-16 of claim 28, the above-quoted statement was the only response in the Examiner's Answer to this argument in the Appeal Brief regarding claim 28.

In rejecting claim 28, the July 24, 2007 Office Action simply stated "[t]he limitations of claim 28 closely parallel those of claims 1-3 and 6-9. Claim 28 is rejected under the same rationale as set forth above in claims 1-3 and 6-9." As pointed out in the Appeal Brief, claim 28 is directed to a "commerce information management **apparatus**" (claim 28, line 1, emphasis added). The analysis of how the prior art discloses what is recited in an apparatus claim differs from a method claim like claim 1, because at a minimum there must be some teaching or suggestion of physical component(s) that perform the operation recited by each of the elements recited in the claim, not merely something somewhere performing a recited operation which is sufficient for a method claim. The July 24, 2007 Office Action lacked that analysis and as a result, the Appeal Brief could not point out how that analysis was incorrect.

It is submitted that the failure to provide a rejection of claim 28 as an apparatus claim in the July 24, 2007 Office Action or to correct this failure in the Examiner's Answer in response to the arguments made in the Appeal Brief means that claim 28, and claim 29 which is also an apparatus claim, should be allowed for lack of a *prima facie* rejection of these apparatus claims.

Remaining arguments in Appeal Brief

On pages 10 and 11 of the Appeal Brief were arguments directed to claim 29 and the rejection of claims 4 and 5 under 35 USC § 103(a). None of these arguments were addressed by the Examiner's Answer. Therefore, it is submitted that at least claims 4, 5 and 29 patentably distinguish over the cited art for the reasons set forth in the Appeal Brief.

Summary

For the reasons set forth above, in the Appeal Brief and in the Amendment filed June 19, 2007, it is submitted that the Examiner's final rejection of the claims is without support and, therefore, erroneous. Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

If any fee is required, please charge same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: June 30, 2008

By: /Richard A. Gollhofer/

Richard A. Gollhofer

Registration No. 31,106

1201 New York Avenue, NW, Suite 700

Washington, D.C. 20005

Telephone: (202) 434-1500

Facsimile: (202) 434-1501